

REMARKS

The following remarks are submitted in response to the Office Action mailed July 12, 2004. Claims 1-52 and 137-219 were withdrawn from consideration. Therefore, claims 53-136 are pending and remain under consideration. Claims 76, 95, 96, and 116 have been amended. No new matter has been added. Reconsideration, reexamination and allowance of the pending claims are respectfully requested.

ALLOWABLE SUBJECT MATTER

Applicants thank the Examiner for indicating that claims 53-75 and 77-94 are allowed, and claims 96 and 116-118 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

35 U.S.C. § 102 CLAIM REJECTIONS

Claim 76 is rejected under 35 U.S.C. § 102(e) as being anticipated by Natarajan et al. (US 6,501,983). The Examiner asserts that Natarajan et al. disclose a housing, an electrical circuit located within the housing, and first and second electrodes on first and second ends of the housing, respectively. Applicants respectfully traverse the rejection.

Claim 76 has been amended to recite an implantable cardioverter-defibrillator having first and second electrodes located on first and second ends of a housing, respectively, wherein a cardioversion-defibrillation energy is delivered between the first and second electrodes. Natarajan et al. do not teach these elements. Natarajan et al. teach a method and implanted device for sensing a myocardial infarction (MI). Fig. 2c is an implanted device having multiple sensor elements on the surface for capturing EGM signals from the various regions of the body. See column 8, lines 29-43. The device of Natarajan et al. with sensors on the ends is disclosed as receiving signals for detecting a MI. Natarajan et al. disclose further embodiments in which the sensing device may also initiate electrical rescue therapy, such as pacing, cardioversion or defibrillation. This embodiment, however, is specifically disclosed as involving giving an electrical shock "via two leads, which may be a combination of the can of the implanted device (801) and an intracavitary lead (833) or a combination of subcutaneous or an epicardial or intrathoracic lead (834) and an intracavitary lead." See column 13, line 66 through column 14,

line 5. Natarajan et al. thus teach at least one intracavitary lead for delivering an electrical shock to the heart. Natarajan et al. do not teach each and every element of the claim and cannot be seen to anticipate the claim. Withdrawal of the rejection is respectfully requested.

Claims 95, 105, 119, and 126-136 are rejected under 35 U.S.C. §102(b) as being anticipated by Causey III (US 5,411,547). The Examiner asserts that Causey III discloses an implantable cardioverter defibrillator with a housing, an electrical circuit within the housing, first and second spaced apart subcutaneous electrodes coupled to the circuit, wherein a cardioversion-defibrillation energy is delivered between the electrodes.

Independent claim 95 has been amended to recite the first subcutaneous electrode is disposed on the housing. This limitation was previously recited in claim 96, which was indicated as allowable by the Examiner. Causey III teaches the first and second electrodes coupled to leads attached to the defibrillator. Causey III does not teach, suggest or contemplate a device with an electrode on the housing, as is now claimed. As such, Causey III fails to teach each and every element of independent claim 95, and claims 105, 119, and 126-136 dependent thereon. Withdrawal of the rejection is respectfully requested.

35 U.S.C. § 103(a) CLAIM REJECTIONS

Claims 97-100, 114, 115, 120-125, and 132-135 are rejected as being unpatentable over Causey III. The rejected claims are all dependent on claim 95, which is patentable over Causey III for at least the reasons set forth above. There is no motivation or guidance for one of ordinary skill in the art to modify the device of Causey III to place an electrode on the defibrillator. An advantage taught by Causey III related to having separate electrodes is that they cannot be connected incorrectly to the implantable defibrillation device. See column 3, lines 54-56. Thus, modifying the device of Causey III to achieve the instant invention would go against the specific teachings of Causey III and could result in destroying the advantage provided by Causey III's design. Withdrawal of the rejection is respectfully requested.

Claims 101-104 are rejected as being unpatentable over Causey III in view of Mouchawar (U.S. 5,601,608). Claims 106-111 are rejected as being unpatentable over Causey III in view of Ostroff (U.S. 5,215,081). Claims 112 and 113 are rejected as being unpatentable over Causey III in view of Yang (U.S. 5,476,503). Claims 101-104 and 106-113 are all

dependent on claim 95, which is patentable over Causey III for at least the reasons set forth above. None of Mouchawar, Ostroff, or Yang provides what Causey III lacks. Additionally, there is no motivation for one of ordinary skill in the art to modify the device of Causey III to achieve the claimed invention. As stated above, modifying Causey III would likely destroy at least one advantage specifically taught by Causey III. Withdrawal of the rejections is respectfully requested.

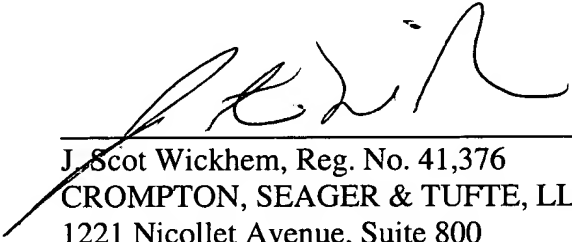
Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Gust H. Bardy et al.

By their Attorney,

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